

an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information; the second database contained on a client computer;

the server computer providing the search results together with the particular advertisement to the user;

the server computer receiving feedback regarding whether the advertisement was successful; and

the associative search engine dynamically altering relational preferences for subsequent correlations of received search arguments to the second database.

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#### REMARKS

In the Office Action, the Examiner rejected claims 1-19, 29-79, and 86-113 under 35 U.S.C. 103(a) as being unpatentable over EP 0749081A1, the Applicant being Pointcast Inc., and referred to hereinafter as "Pointcast." For reasons unknown to the Applicants, in this Office Action and in the prior Office Action, the Examiner refers to this EP reference as "Blount". In the Office Action, the Examiner also cites "The Search Engine Report," dated July 23, 1996. Whether the Examiner in fact relied upon this reference in rejecting the pending claims under 35 U.S.C. 103(a) is unclear. In any case, the Applicants respectfully traverse these rejections and distinguish each of these references.

#### The Pointcast (referred to as Blount by the Examiner) Reference

Pointcast is directed to a system in which advertisements are assigned to information items at an Information Server. The information items and assigned advertisements are then downloaded from the Information to a user's workstation and stored in the workstation's local

memory. When the workstation meets predefined idleness criteria, an information display controller of the workstation causes at least a subset of the information items and assigned advertisements to be displayed on the workstation's display. Subscriber profile data may be used to limit information items and assigned advertisements that are displayed.

These teachings are clearly described in the Abstract, Summary, and Description sections of Pointcast. The Pointcast reference therefore discloses a system that statically assigns advertisements to information items and then periodically downloads such information items and assigned advertisements and to the workstations. When a particular information item is displayed to a user on his/her workstation, the assigned advertisement(s) are also displayed to the user.

The Search Engine Report dated July 23, 1996

The Search Engine Report is a trade publication. At page 2 of the Office Action, the Examiner asserts that this edition of the Search Engine Report teaches: "searching a data network based upon a search argument, correlating the search argument to a particular advertisement, displaying search results with the particular advertisement." The Examiner cites the author as stating that these limitations are "not merely well known but even having 'caused some controversy.'" A careful reading of this issue of the Search Engine Report reveals that what has "caused some controversy" is the "selling" of keywords, not the limitations described by the Examiner. When a keyword is "sold" to a purchaser by a search engine provider, the seller's search engine, in response to the "sold" keyword, will cause the search engine to yield the purchaser's web page URL.

Claims 1-6, 9, and 11-19 are not rendered obvious by the cited references

Claims 1-6 are directed toward a method of providing advertisements to a user searching

for desired information within a data network. In particular, claim 1 requires receiving, from the user, a search request including a search argument corresponding to the desired information, searching, based upon the received search argument, a first database having data network related information to generate search results, correlating the received search argument to a particular advertisement in a second database having advertisement related information, and providing the search results together with the particular advertisement to the user.

The Examiner states that at Page 9, Table 1, the Pointcast reference discloses: “receiving, from the user, a search request including a search argument corresponding to the desired information.” Table 1 is directed to operation of a Screen Saver. The operations described in this table have NOTHING to do with the receipt of a search request from a user. As described at page 8 line 50, the procedures of Table 1 are invoked when “a lack of user inputs” is detected. The operations of Table 1 are invoked when NO USER INPUT is received, quite different than “receiving, from the user, a search request including a search argument corresponding to the desired information.” The Pointcast reference therefore does not disclose, suggest, or teach this element of claim 1.

The Examiner states that at Page 9, Table 1, the Pointcast reference discloses: “searching, based upon the received search argument, a first database having data network related information to generate search results.” As described above, Table 1 at Page 9 is directed to the operation of a Screen Saver that displays information. The operations described in Table 1 do NOT disclose, suggest, or teach searching of a database based upon a received search argument as required by the element of claim 1 in question.

The Examiner states that at Page 12, Table 2, the Pointcast reference discloses: “correlating the received search argument to a particular advertisement in a second database

having advertisement related information.” Table 2 is directed to the update of the database of a workstation with new information items and advertisements, these operations completely different than correlating a search argument to a particular advertisement. Table 2 does NOT disclose, suggest, or teach correlating the received search argument to a particular advertisement  
5 in a second database having advertisement related information as required by the claim element at issue.

The Examiner states that at Page 12, Table 2, the Pointcast reference discloses “providing the search results together with the particular advertisement to the user.” As described above, Table 2 is directed primarily to the update of the database of a workstation with new information  
10 items and advertisements. The update of a database is not the same or similar to providing search results and advertisements to a user. Table 2 thus does not disclose, suggest, or teach the requirements of the claim element in question.

The Examiner cites The Search Engine Report dated July 23, 1996 as disclosing “correlating the received search argument to a particular advertisement in a second database  
15 having advertisement related information.” As was described above the Search Engine Report discusses “selling keywords,” which is not pertinent to this element of claim 1.

For these reasons the cited references fail to disclose, suggest, or teach the elements of claim 1 and claim 1 is allowable over the cited references. Claims 2-6 depend from claim 1 and are allowable for these reasons and the additional reasons introduced by the additional  
20 limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claim 9 is directed to a system for providing advertisements to a user searching for desired information within a data network. Claim 9 requires means for receiving, from the user a search request including a search argument corresponding to the desired information, means for

searching, based upon the received search argument, a first database having data network related information to generate search results, means for correlating the received search argument to a particular advertisement in a second database having advertisement related information, and means for providing the search results together with the particular advertisement to the user. The

5 Pointcast reference and the other references fail to disclose each of the limitations of claim 9 and claim 9 is allowable over the cited references.

Claim 11 is directed toward a method of providing advertisements to a user searching for desired information within a data network. Claim 11 requires receiving, at a server, a search request sent from a user, the search request including a search argument corresponding to the

10 desired information, searching, by the server computer based upon the received search argument, a first database to generate search results, the first database having data network related information and being contained on the server computer, correlating the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer, and providing the search results

15 together with the particular advertisement to the user. The Pointcast reference and the other references fail to disclose each of these limitations of claim 11 and claim 11 is allowable over the cited references.

Claims 12-19 depend from claim 11 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught,

20 disclosed, or suggested by the cited references. The Pointcast reference and the other references fail to meet the limitations of claims 11-19.

Claims 7-8, 10 are not rendered obvious by the cited references

Claims 7-8 are directed toward a method of searching for desired information within a data network. In particular, claim 7 requires receiving, from a user, a search request including a search argument corresponding to the desired information, searching, based upon the received search argument and user profile data, a database of information to generate a search result, and providing the search results to the user. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose, suggest, or teach each of these limitations of claim 7 and claim 7 is allowable over the cited references.

Claim 8 depends from claim 7 and is allowable for these reasons and the additional reasons introduced by the additional limitations of this claim, which are not taught, disclosed, or suggested by the cited references.

Claim 10 is directed to a system for searching for desired information within a data network. Claim 10 requires means for receiving, from a user, a search request including a search argument corresponding to the desired information, means for searching, based upon the received search argument and user profile data, a database of information to generate a search result, and means for providing the search results to the user. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 10 and claim 10 is allowable over the cited references.

Claims 29-35 are not rendered obvious by the cited references

Claim 29 is directed to a method for providing search results to a user that correspond to desired information within a data network. Claim 29 requires receiving, from the user, a search request that includes a search argument corresponding to the desired information, searching, based upon the received search argument, a database having data network related information to

generate search results, retrieving user profile data for the user, re-prioritizing the search results based upon the user profile data to produce re-prioritized search results, and providing the re-prioritized search results to the user. For the same or similar reasons as cited above, the Pointcast reference and the other cited reference fail to disclose each of these limitations of claim

5 29 and claim 29 is allowable over the cited references.

Claims 30-35 depend from claim 29 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 36-40 are not rendered obvious by the cited references

10 Claim 36 is directed to a method for providing search results to a user that correspond to desired information within a data network. Claim 36 requires receiving, from the user, a search request that includes a search argument corresponding to the desired information, retrieving user profile data for the user, creating a modified search argument based upon the user profile data and the search argument, searching, based upon the modified search argument, a database having  
15 data network related information to generate search results, and providing the search results to the user. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 36 and claim 36 is allowable over the cited references.

Claims 37-40 depend from claim 36 and are allowable for these reasons and the  
20 additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 41-45 are not rendered obvious by the cited references

Claim 41 is directed to a method for providing search results to a user that correspond to desired information within a data network. Claim 41 requires receiving, from the user, a search request that includes a search argument corresponding to the desired information, retrieving user profile  
5 data for the user, determining a particular database to search based upon the user profile data, the particular database having network related information relating to the user profile data, searching, based upon the search argument, the particular database to generate search results, and providing the search results to the user. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 41  
10 and claim 41 is allowable over the cited references.

Claims 42-45 depend from claim 41 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 46-48 are not rendered obvious by the cited references

15 Claim 46 is directed to a method for presenting advertisements to a user accessing a data network via an end user device. Claim 46 requires transmitting a plurality of advertisements to the user via the end user device, for each of the plurality of advertisements presented to the user via the user device, recording an environment within which the advertisement was presented, for each of the plurality of advertisements transmitted to the user via the user device, determining  
20 whether the advertisement was successful, and altering the environment of subsequent advertisements transmitted to the user via the user device based upon the environment of prior successful advertisements. For the same or similar reasons as cited above, the Pointcast



reference and the other references fail to disclose each of these limitations of claim 46 and claim 46 is allowable over the cited references.

Claims 47-48 depend from claim 46 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught,  
5 disclosed, or suggested by the cited references.

Claims 49-52 are not rendered obvious by the cited references

Claim 49 is directed to method for presenting advertisements to a user accessing a data network via an end user device. Claim 49 requires receiving a plurality of advertisements at the end user device, presenting the plurality of advertisements to the user at the end user device, each of the  
10 plurality of advertisements presented in a particular respective environment, for each of the plurality of advertisements presented to the user at the user device, recording the environment within which the advertisement was presented, for each of the plurality of advertisements presented to the user at the user device, determining whether the advertisement was successful, altering the environment of a subsequent advertisement received at the end use device based  
15 upon the environment of prior successful advertisements, and presenting the subsequent advertisement to the user with an altered environment. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 49 and claim 49 is allowable over the cited references.

Claims 50-52 depend from claim 49 and are allowable for these reasons and the  
20 additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 53-57 are not rendered obvious by the cited references

Claim 53 is directed to a method for providing search results to a user that correspond to desired information within a data network. Claim 53 requires receiving, from the user, a search request that includes a search argument corresponding to the desired information, retrieving user  
5 profile data for the user, searching, based upon the search argument, a database having data network related information to generate search results, creating an enhanced presentation environment for the user based upon the user profile data, and providing the search results to the user within the enhanced presentation environment. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of  
10 claim 53 and claim 53 is allowable over the cited references.

Claims 54-57 depend from claim 53 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 58-63 are not rendered obvious by the cited references

15 Claim 58 is directed to a method for providing advertisements to a user searching for desired information within a data network. Claim 58 requires receiving, from the user, a search request including a search argument corresponding to the desired information, searching, based upon the received search argument, a first database having data network related information to generate search results, correlating the received search argument to a particular advertisement in a second  
20 database having advertisement related information, providing the search results together with the particular advertisement to the user, determining whether the advertisement was successful, and altering criteria for subsequent correlations of received search arguments to the second database. For the same or similar reasons as cited above, the Pointcast reference and the other references

fail to disclose each of these limitations of claim 58 and claim 58 is allowable over the cited references.

Claims 59-63 depend from claim 58 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught,  
5 disclosed, or suggested by the cited references.

Claims 64-68 are not rendered obvious by the cited references

Claim 64 is directed to a method for providing advertisements to a user searching for desired information within a data network. Claim 64 requires receiving, from the user, a search request including a search argument corresponding to the desired information, searching, based upon the  
10 received search argument, a first database having data network related information to generate search results, correlating the received search argument to a particular advertisement in a second database having advertisement related information, providing the search results together with the particular advertisement to the user, determining that the advertisement was successful, and tracking a toll due by an associated seller. For the same or similar reasons as cited above, the  
15 Pointcast reference and the other references fail to disclose each of these limitations of claim 64 and claim 64 is allowable over the cited references.

Claims 65-68 depend from claim 64 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

20 Claims 69-74 are not rendered obvious by the cited references

Claim 69 is directed to a method for providing advertisements to a user searching for desired information within a data network. Claim 69 requires receiving, from the user, a search request including a search argument corresponding to the desired information, searching, based

upon the received search argument, a first database having data network related information to generate search results, correlating the received search argument to a particular advertisement in a second database having advertisement related information, providing the search results together with the particular advertisement to the user, receiving feedback regarding whether the advertisement was successful, and dynamically altering relational preferences for subsequent correlations of received search arguments to the second database. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 69 and claim 69 is allowable over the cited references.

Claims 70-74 depend from claim 69 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 75-79 are not rendered obvious by the cited references

Claim 75 is directed to an advertising machine for providing advertisements to a user searching for desired information within a data network. Claim 75 requires a server computer coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information, a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first database to generate search results, the first database having data network related information and being contained on the server computer, an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer, and the server computer providing the search results together with the particular advertisement to the user. For the same or similar reasons as cited above, the Pointcast reference

and the other references fail to disclose each of these limitations of claim 75 and claim 75 is allowable over the cited references.

Claims 76-79 depend from claim 75 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught,  
5 disclosed, or suggested by the cited references.

Claims 86-90 are not rendered obvious by the cited references

Claim 86 is directed to a search engine for providing search results to a user that correspond to desired information within a data network. Claim 86 requires a server computer coupled to the data network that receives, from the user, a search request that includes a search argument  
10 corresponding to the desired information, a database search engine coupled to the server computer that searches, based upon the received search argument, a contextual database having data network related information to generate search results, the server computer retrieves user profile data for the user, the server computer re-prioritizes the search results based upon the user profile data to produce re-prioritized search results, and the server computer provides the re-  
15 prioritized search results to the user. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 86 and claim 86 is allowable over the cited references.

Claims 87-90 depend from claim 86 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught,  
20 disclosed, or suggested by the cited references.

Claims 91-93 are not rendered obvious by the cited references

Claim 91 is directed to a search engine for providing search results to a user that correspond to desired information within a data network. Claim 91 requires a server computer

coupled to the data network that receives, from the user, a search request that includes a search argument corresponding to the desired information, the server computer retrieves user profile data for the user, the server computer creates a modified search argument based upon the user profile data and the search argument, a database search engine coupled to the server computer  
5 that searches, based upon the modified search argument, a database having data network related information to generate search results, and the server provides the search results to the user. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 91 and claim 91 is allowable over the cited references.

Claims 92-93 depend from claim 91 and are allowable for these reasons and the  
10 additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 94-96 are not rendered obvious by the cited references

Claim 94 is directed to a search engine for providing search results to a user that correspond to desired information within a data network. Claim 94 requires a server computer  
15 coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information, the server computer retrieves user profile data for the user, an associative search engine coupled to the server computer that determines a particular database to search based upon the user profile data, the particular database having network related information relating to the user profile data, a  
20 database search engine coupled to the server computer that searches, based upon the search argument, the particular database to generate search results, and the server computer provides the search results to the user. For the same or similar reasons as cited above, the Pointcast reference

and the other references fail to disclose each of these limitations of claim 94 and claim 94 is allowable over the cited references.

Claims 95-96 depend from claim 94 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught,  
5 disclosed, or suggested by the cited references.

Claims 97-98 are not rendered obvious by the cited references

Claim 97 is directed to an advertising machine coupled to a data network for providing advertisements to a user. Claim 97 requires a server computer coupled to the data network that transmits a plurality of advertisements to the user via the data network and an end user device,  
10 the server computer, for each of the plurality of advertisements presented to the user via the user device, records an environment within which the advertisement was presented, the server computer, for each of the plurality of advertisements transmitted to the user via the user device, determines whether the advertisement was successful, and the server computer altering the environment of subsequent advertisements transmitted to the user via the data network and the  
15 user device based upon the environment of prior successful advertisements. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 97 and claim 97 is allowable over the cited references.

Claim 98 depends from claim 97 and is allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed,  
20 or suggested by the cited references.

Claims 99-102 are not rendered obvious by the cited references

Claim 99 is directed to an end user device that couples to a data network and that presents advertisements to a user. Claim 99 requires a data network interface that couples to the data

network and receives a plurality of advertisements at the end user device, a processor that couples to the data network interface, a display coupled to the processor and the data network interface upon which the plurality of advertisements are presented to the user; each of the plurality of advertisements presented in a particular respective environment, the processor, after  
5 each of the plurality of advertisements presented to the user at the user device, recording the environment within which the advertisement was presented, the processor, for each of the plurality of advertisements presented to the user at the user device, determining whether the advertisement was successful, the processor altering the environment of a subsequent advertisement based upon the environment of prior successful advertisements, and the display  
10 presenting the subsequent advertisement to the user with an altered environment. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 99 and claim 99 is allowable over the cited references.

Claims 100-102 depend from claim 99 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught,  
15 disclosed, or suggested by the cited references.

Claims 103-106 are not rendered obvious by the cited references

Claim 103 is directed to a search engine for providing search results to a user that correspond to desired information within a data network. Claim 103 requires a server computer coupled to the data network that receives a search request from the user, the search request  
20 including a search argument corresponding to the desired information, the server computer retrieves user profile data for the user, a database search engine coupled to the server computer that searches, based upon the search argument, the particular database to generate search results, the server computer provides the search results to the user, the server computer creates an



enhanced presentation environment for the user based upon the user profile data, and the server computer provides the search results to the user within the enhanced presentation environment.

For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 103 and claim 103 is allowable over the cited  
5 references.

Claims 104-106 depend from claim 103 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claims 107-108 are not rendered obvious by the cited references

10 Claim 107 is directed to an advertising machine coupled to a data network for providing advertisements to a user. Claim 107 requires a server computer coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information, a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first  
15 database to generate search results, the first database having data network related information and being contained on the server computer, an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer, the server computer providing the search results together with the particular  
20 advertisement to the user, the server computer determining whether the advertisement was successful, and the server computer altering criteria for subsequent correlations of received search arguments to the second database. For the same or similar reasons as cited above, the

Pointcast reference and the other references fail to disclose each of these limitations of claim 107 and claim 107 is allowable over the cited references.

Claim 108 depends from claim 107 and is allowable for these reasons and the additional reasons introduced by the additional limitations of the claim, which are not taught, disclosed, or suggested by the cited references.

Claims 109-112 are not rendered obvious by the cited references

Claim 109 is directed to an advertising machine for providing advertisements to a user searching for desired information within a data network. Claim 109 requires a server computer coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information, a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first database to generate search results, the first database having data network related information and being contained on the server computer, an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer, the server computer providing the search results together with the particular advertisement to the user, the server computer determining that the advertisement was successful, and the server computer tracking a toll due by an associated seller. For the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 109 and claim 109 is allowable over the cited references.

Claims 110-112 depend from claim 109 and are allowable for these reasons and the additional reasons introduced by the additional limitations of these claims, which are not taught, disclosed, or suggested by the cited references.

Claim 113 is not rendered obvious by the cited references

Claim 113 is directed to an advertising machine for providing advertisements to a user searching for desired information within a data network. Claim 113 requires a server computer coupled to the data network that receives a search request from the user, the search request  
5 including a search argument corresponding to the desired information, a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first database to generate search results, the first database having data network related information and being contained on the server computer, an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in  
10 a second database having advertisement related information, the second database contained on a client computer, the server computer providing the search results together with the particular advertisement to the user, the server computer receiving feedback regarding whether the advertisement was successful, and the associative search engine dynamically altering relational preferences for subsequent correlations of received search arguments to the second database. For  
15 the same or similar reasons as cited above, the Pointcast reference and the other references fail to disclose each of these limitations of claim 113 and claim 113 is allowable over the cited references.

Thus, pending claims 1-19, 29-79, and 86-113 are now allowable. A Notice of Allowance is courteously solicited. Please direct any questions to the undersigned attorney.

Respectfully submitted,

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